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Home

Index

Search

System
AlertseBusiness
CenterNews &
Notices

Contact Us

Manual of Patent Examining Procedure (MPEP)

filing 5/28/99

Go to MPEP - Table of Contents

browse before

706.02(l)(1) Rejections Under 35 U.S.C. 102(e)/103; 35 U.S.C. 103(c) - 700 Examination of Applications

706.02(l)(1) Rejections Under 35 U.S.C. 102(e)/103; 35 U.S.C. 103(c) [R-1]

35 U.S.C. 103 Conditions for patentability; non-obvious subject matter.

(c) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Effective November 29, 1999, subject matter which was prior art under former 35 U.S.C. 103 via 35 U.S.C. 102(e) is now disqualified as prior art against the claimed invention if that subject matter and the claimed invention "were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." This change to 35 U.S.C. 103(c) applies to all utility, design and plant patent applications filed on or after November 29, 1999, including continuing applications filed under 37 CFR 1.53(b), continued prosecution application filed under 37 CFR 1.53(d), and reissues. The amendment to 35 U.S.C. 103(c) does not affect any application filed before November 29, 1999, a request for examination under 37 CFR 1.129 of such an application, nor a request for continued examination under 37 CFR 1.114 of such an application. >The Intellectual Property and High Technology Technical Amendments Act of 2002 (Pub. L. 107-273, 116 Stat. 1758 (2002) did not further amend the exclusion under 35 U.S.C. 103(c) as amended on November 29, 1999.<

The mere filing of a continuing application on or after November 29, 1999, with the required evidence of common ownership, will serve to exclude commonly owned 35 U.S.C. 102(e) prior art that was applied, or could have been applied, in a rejection under 35 U.S.C. 103 in the parent application. For reissue applications, the doctrine of recapture may prevent the presentation of claims that were cancelled or amended to overcome such prior art applied in the application which matured into the patent for

which reissue is being sought. The recapture doctrine prevents the presentation of claims in reissue applications that were amended or cancelled from the application which matured into the patent for which reissue is being sought, if the claims were amended or cancelled to distinguish the claimed invention from 35 U.S.C. **102(e)/ 103** prior art which was commonly owned or assigned at the time the invention was made.

35 U.S.C. **103(c)** applies only to prior art usable in an obviousness rejection under 35 U.S.C. 103. Subject matter that qualifies as anticipatory prior art under 35 U.S.C. **102**, including 35 U.S.C. **102(e)**, is not affected, and may still be used to reject claims as being anticipated.

The burden of establishing that subject matter is disqualified as prior art is placed on applicant once the examiner has established a *prima facie* case of obviousness based on the subject matter.

See MPEP § **706.02(l)(2)** for information regarding establishing common ownership. See MPEP § **706.02(l)(3)** for examination procedure with respect to 35 U.S.C. **103(c)**. Non-statutory and statutory double patenting rejections, based on subject matter now disqualified as prior art in amended 35 U.S.C. **103(c)**, should still be made as appropriate. See MPEP § **804**.

browse after

**HOME | INDEX | SEARCH | SYSTEM STATUS | BUSINESS CENTER | NEWS&NOTICES |
CONTACT US | PRIVACY STATEMENT**

Go to **MPEP - Table of Contents**